

**THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed: 9/16/04

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Merz Pharmaceuticals, LLC

Serial No. 76364848

G. Patrick Sage of Hueschen and Sage for applicant.

Fred Mandir, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Quinn, Bottorff and Rogers, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed to register the mark SKIN
CARE FOR SCARS for "pharmaceuticals, namely, a gel, cream,
or ointment designed to improve the appearance of scars,
blemishes, and other skin imperfections."¹ Applicant has
claimed that its mark has acquired distinctiveness under
Section 2(f) of the Trademark Act.

The trademark examining attorney refused

¹ Application Serial No. 76364848, filed January 30, 2002,
alleging first use anywhere and first use in commerce on April 3,
1997.

registration on the following grounds: 1) that under Sections 1, 2 and 45 of the Trademark Act, the designation sought to be registered does not function as a mark, but rather merely acts as an informational phrase; 2) that if it is determined that the designation would be perceived as being something more than merely an informational phrase, the designation is nevertheless generic under Section 2(e)(1) of the Trademark Act and, thus, is not registrable on the Principal Register; 3) and that, if the designation is not generic but rather merely descriptive, the Section 2(f) claim of acquired distinctiveness is insufficient.

When the refusals were made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

Applicant contends that the designation sought to be registered functions as a trademark for the goods identified in its application. Applicant also argues that the designation is not descriptive, let alone generic, and yet, at the same time, applicant has claimed the benefits of acquired distinctiveness under Section 2(f).² In support

² Notwithstanding applicant's argument, applicant has conceded the mere descriptiveness of the designation sought to be registered by its seeking registration pursuant to Section 2(f). In essence, applicant's Section 2(f) claim of acquired distinctiveness is a concession that the mark is not inherently distinctive and that it therefore is not registrable on the Principal Register absent a sufficient showing of acquired

thereof, applicant relies on the declaration of Robert Burgess, applicant's chief financial officer and vice president of administration, wherein he asserts that the designation has become distinctive of the goods through applicant's substantially exclusive and continuous use in commerce of SKIN CARE FOR SCARS for at least five years preceding the date of his declaration. Applicant also submitted a copy of the June 2002 edition of *OTC Supplement to Pharmacy Times* showing a survey of pharmacists' preferences and recommendations of over-the-counter (OTC) products, including applicant's.

The examining attorney maintains that the involved designation would not be perceived by consumers as a trademark for the goods, but rather only as informational matter about the goods. In the event it is determined that consumers would perceive the designation as something more than merely an informational phrase, the examining attorney then argues that the designation is generic. If the

distinctiveness. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ["Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact."] (emphasis in original); and *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443 (TTAB 1994). So as to be clear on this point, applicant has not claimed acquired distinctiveness in the alternative. See *In re E S Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992); TMEP § 1212.02(c) (3d ed. rev. May 2003). Thus, the issue of mere descriptiveness is not an issue in this appeal.

designation is found to be not generic, but rather just merely descriptive, the examining attorney further contends that the evidence of record falls far short of establishing a claim of acquired distinctiveness. In support of the refusal, the examining attorney submitted a dictionary listing of the term "skin care," as well as excerpts of web pages retrieved from the Internet.

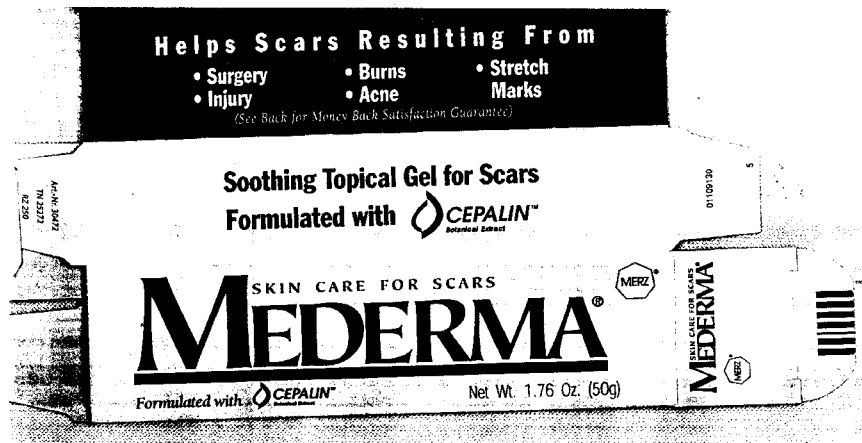
Failure to Function as a Trademark

Section 45 of the Trademark Act defines the term "trademark" in relevant part as including "any word, name, symbol, or device, or any combination thereof--(1) used by a person....to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." In this regard, the Court of Customs and Patent Appeals, a predecessor to the Court of Appeals for the Federal Circuit, stated the following: "The Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be registration, there must be a trademark, and unless words have been so used they cannot qualify." In re Bose Corp., 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976), citing In re Standard Oil Co., 275 F.2d 945, 125 USPQ 227 (CCPA 1960).

We note that not every word or combination of words which appears on or in connection with an entity's goods functions as a trademark. In re Boston Beer Co., 47 USPQ2d 1914 (TTAB 1998), *aff'd*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); and In re Morganroth, 208 USPQ 284 (TTAB 1980). Thus, the mere fact that an applicant's informational phrase appears on the specimens, even separate and apart from other indicia which appear on them, does not make it a trademark. To be a mark, the phrase must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods. Mere intent that a term or phrase function as a trademark is not enough in and of itself. Id. at 287 ["Wishing does not make a trademark or service mark be."] A critical element in determining whether a term or phrase is a trademark is the impression the term or phrase makes on the relevant public. In re Volvo Cars of North America, Inc., 46 USPQ2d 1455 (TTAB 1998). Accordingly, in this case, the critical inquiry becomes: Would the designation SKIN CARE FOR SCARS be perceived as a source indicator or merely an informational phrase? In re Remington Products Inc., 3 USPQ2d 1714, 1715 (TTAB 1987). See generally: J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 7:23 (4th ed. 2002). In order to

assess the commercial impact created by the designation involved here, we look to the specimens and other materials which show how the mark is actually used in the marketplace. In re Bose Corp., supra.

A copy of a box for applicant's product, submitted as a specimen, is reproduced below.



Also of record is a promotional sheet for applicant's product, which includes a form to register to receive applicant's "MEDERMA® SKIN CARE NEWSLETTER." The designation sought to be registered is uniformly used throughout the text of the promotional sheet as follows: "MEDERMA® Skin Care For Scars."

Based on the evidence of record, we find that the designation SKIN CARE FOR SCARS is merely an informational phrase that would not be perceived as a trademark. Applicant's own uses, both in its specimen and in its promotional sheet, clearly show the designation in a

subordinate fashion to the mark MEDERMA. These uses convince us that the designation SKIN CARE FOR SCARS is nothing more than an informational phrase which gives consumers an immediate idea about the specific nature of the goods. As such, consumers are not likely to view the designation as signifying the source or origin of the goods in connection with which it is used. In re Manco Inc., 24 USPQ2d 1938 (TTAB 1992); In re Melville Corp., 228 USPQ 970 (TTAB 1986); and In re Superba Cravats, Inc., 149 USPQ 852 (TTAB 1966).

The refusal to register is affirmed.

Genericness

A designation is a generic name if it refers to the class or category of goods and/or services on or in connection with which it is used. In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a designation is generic is its primary significance to the relevant public. Section 14(3) of the Trademark Act; In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and H. Marvin Ginn

Corp. v. International Association of Fire Chiefs, Inc., supra. The United States Patent and Trademark Office has the burden of establishing by "clear evidence" that a designation is generic and thus unregistrable. In re Merrill Lynch, Pierce, Fenner and Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a designation may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

Our first task under Marvin Ginn is to determine, based on the evidence of record, the genus of applicant's goods. Applicant's promotional sheet, which sets forth detailed information about applicant's product, reveals that applicant produces a skin care product used to treat scars. In a section of the sheet captioned "What is MEDERMA® Skin Care For Scars?", applicant indicates that "MEDERMA® Skin Care For Scars is the first topical gel formulated to help scars appear softer and smoother." Thus, the genus of goods involved herein may be accurately identified as "pharmaceutical gel, cream or ointment for use to improve the appearance of scars."

We must next determine whether the designation SKIN CARE FOR SCARS is understood by the relevant purchasing public primarily to refer to that genus of goods. In this case, the relevant purchasers are ordinary consumers of skin care products for scarred skin.

The examining attorney introduced a dictionary definition of "skin care": "care for the skin." (www.dictionary.com). Also of record is a dictionary definition of "scar," showing its meaning as "a mark left on part of the body after an injury, such as a cut, has healed." (*Cambridge Advanced Learner's Dictionary* (2003)). One of the uses found on the Internet is the following description of a competing product for sale: "Scarguard is Serious Skin Care for Scars." The examining attorney's search of the Internet also revealed the following uses: "Men's Skin Care Store from Greatskin.com"; "Biomedic--More Great Skin Care from Greatskin.com"; "Tips on makeup, fragrance, hair and skin care"; and "Skin Care Books from Amazon.com". A review of the Internet on-line shopping site, www.skinstore.com, shows a listing for applicant's product with the accompanying description: "Mederma skin care for scars can help scars that are the results of surgery, burns, accidents, injuries, and acne appear softer and smoother." Another on-line shopping site,

www.metaiq.com, identifies a particular category of products named "Skin Care," and allows visitors to "Compare Prices For Skin Care At These Top Shopping Sites." This site provides links to other on-line shopping sites wherein the following uses are revealed: "professional skin care line"; "Buy skin care products from dermatologist N.V. Perricone, M.D."; "site offers info about Environ and its skin care products"; "anti-aging skin care products"; and "Scriptmeds offers a variety of skin care products."

The Federal Circuit, in American Fertility, stated that "[t]he board cannot simply cite definitions and generic uses of the constituent terms of a mark....in lieu of conducting an inquiry into the meaning of the disputed phrase as a whole to hold a mark....generic." 51 USPQ2d at 1836. The Federal Circuit went on to state that the prior case of In re Gould Paper Corp., 835 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) "is limited, on its facts, language, and holding, to compound words formed by the union of words" and that it was legally erroneous to apply language found in the Gould case "to phrases consisting of multiple terms, which are not 'joined' in any sense other than appearing as a phrase." Id. at 1837. The Federal Circuit further stated that "the correct legal test....is set forth in Marvin Ginn and is to be applied to a mark, or disputed

phrase thereof, as a whole, for the whole may be greater than the sum of its parts." Id.

In light of the Federal Circuit's decision in American Fertility, we are constrained to find that the examining attorney has failed to show that the designation as a whole, SKIN CARE FOR SCARS, has acquired no additional meaning to purchasers of gel, cream or ointment to treat scars than the terms "skin care" and "scars" have individually. That is to say, although the terms "skin care" and "scars" are generic for applicant's goods, the record falls short of establishing that the phrase SKIN CARE FOR SCARS, as a whole, is generic. The record includes only one isolated instance where someone in the trade used the specific designation "skin care for scars" in a generic manner. The only other generic use of the phrase as a whole is the reference by skinstore.com to applicant's product. This is not a case where the Office has clearly proven that the designation as a whole is no less generic than its constituents. While "skin care for scars" is certainly an apt name for a skin care product for treating scars, the evidence does not show that it is used as a generic name for such goods. Aptness is insufficient to prove genericness.

We find, based on the evidence of record, that the Office has not met its burden of establishing by clear evidence that the designation SKIN CARE FOR SCARS, as a whole, is generic for the identified goods. See *In re Merrill Lynch*, supra. Genericness is a fact-intensive determination, and the Board's conclusion must be governed by the record that is presented to it. Although we have concerns here about the genericness of applicant's designation, it is the record evidence bearing on purchasers' perceptions that controls the determination, not general legal rules or our own subjective opinions. Any doubts raised by the lack of evidence must be resolved in applicant's favor. Id. Further, on a different and more complete record, such as might be adduced by a competitor in an opposition proceeding, we might arrive at a different result on the issue of genericness.

This refusal to register is reversed.

Acquired Distinctiveness

As indicated earlier, applicant's resort to Section 2(f) acts as a concession that the designation SKIN CARE FOR SCARS is not inherently distinctive, but rather is merely descriptive. We would add that, in any event, the evidence of record establishes that the designation sought to be registered is highly descriptive. On the Section

2(f) issue, applicant has the burden of proving that its designation has acquired distinctiveness. In re Hollywood Brands, Inc., 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) ("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"). "[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." Yamaha International Corp., supra at 1008. In this case that standard is extremely difficult to meet since, even though SKIN CARE FOR SCARS has not been shown to be generic for applicant's goods, it must be considered highly descriptive of them.

Applicant relies on its use of the designation in connection with its goods for five years. The only other evidence relied upon by applicant to show acquired distinctiveness is the listing of applicant's product in a survey appearing in *OTC Supplement to Pharmacy Times*. This publication's "Master List," recognizing brands that earn pharmacists' recommendations at least 49% of the time, includes applicant's as one of the brands (49.3%). The listing identifies applicant's product as a "scar treatment" product, and the listing is accompanied by a reproduction of applicant's logo brand name just as it appears on boxes for the product (see above, the only

difference being the use of "TM" after SKIN CARE FOR SCARS).³

The five years of use claimed by applicant is a relatively short period of time. Further, the only thing the listing in the survey demonstrates is that applicant's product is perceived as a good product, worthy enough that pharmacists often recommend it to consumers. This evidence fails to show that ordinary consumers have come to view SKIN CARE FOR SCARS as a source-identifying mark of applicant's. The issue here is the achievement of distinctiveness, and the evidence falls far short of establishing this. Simply put, the record is completely devoid of direct evidence that ordinary consumers view SKIN CARE FOR SCARS as a distinctive source indicator for applicant's goods.

Accordingly, given the highly descriptive nature of the designation SKIN CARE FOR SCARS, much more evidence (especially in the form of direct evidence from customers) than what applicant has submitted would be necessary to show that the designation has become distinctive of applicant's goods. That is to say, the greater the degree

³ It should be noted, however, that use of "TM" does not transform this unregistrable phrase into a trademark indicating source of origin. In re Volvo Cars of North America, Inc., supra.

of descriptiveness, the greater the evidentiary burden on the applicant to establish acquired distinctiveness.

Yamaha International Corp. v. Hoshino Gakki Co., supra; and In re Merrill Lynch, Pierce, Fenner & Smith, Inc., supra.

We affirm the examining attorney's finding that applicant's Section 2(f) evidence is insufficient to overcome the Section 2(e)(1) mere descriptiveness refusal.⁴

Conclusion

Applicant's designation SKIN CARE FOR SCARS does not function as a mark. Further, the designation has not been shown to be generic for the goods recited in the application. However, the designation is highly descriptive as applied to the goods, and applicant has not demonstrated that its proposed mark has acquired distinctiveness.

Decision: The refusal of registration on the ground that the involved designation does not function as a mark is affirmed. The refusal to register on the ground of genericness is reversed. The examining attorney's finding that applicant failed to establish acquired distinctiveness is affirmed.

⁴ We also point out that, in any event, no amount of Section 2(f) evidence would suffice to overcome the "merely informational" refusal under Sections 1, 2 and 45 of the Trademark Act. In re Tilcon Warren, Inc., 221 USPQ 87 (TTAB 1984).